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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,290	12/03/2003	Peter M. Bonutti	780-A03-012D	6924

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MIAMI, FL 33180

EXAMINER
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PHILOGENE, PEDRO

ART UNIT	PAPER NUMBER
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3733

MAIL DATE	DELIVERY MODE
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05/20/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/727,290	<b>Applicant(s)</b> BONUTTI, PETER M.	
	<b>Examiner</b> Pedro Philogene	<b>Art Unit</b> 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |



***Priority***

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. The examiner agrees with applicant, for purpose of examination, the application is entitled to a priority date of the file date of application No. 09/941,185, or August 28, 2001.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 11-13,15-28,30-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacArthur. (6,342,075) in view of Coates et al. (5,100,409).

MacArthur discloses a prosthetic implant system for repairing a knee joint in a body of a patient, comprising a first member (90) including a first articulating member, the first member affixable to only one of a medial and lateral condyle of a femur portion of the knee joint; as best seen in FIG.8, a second member (90) including an articulating surface, the second member affixable to a trochlear section of the femur portion; as best seen in FIG.9 (at the intercondylar notch or trochlear section (28)); a third member (100) including a third articulating surface, the third member affixable to an end portion of a tibia portion of the knee joint opposite the first member; as best seen in FIG.2. the first and second implants are implanted without a requirement for severing either crutiate ligament, asset forth in column12, lines 20-30.

With respect to claims 2,6-11, MacArthur discloses all the limitations; as set forth in column 8, lines 15-67, column 13, lines 1-67, column 14, lines 1-67, column 15, lines 1-67, column 14, lines 1-30.

With respect to the method claims, the method steps, as set forth, would have been inherently carried out in the operation of the device, as set forth above.

It is noted that McArthur did not teach that first and the second are connected; as claimed by applicant. However, McArthur teaches that the first and second members are separable. Since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art; or, forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. See *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893); *Nerwin v. Erlichman*, 168 USPQ 177, 179; it would have been obvious to one having ordinary skill

in the art at the time the invention was made to modify the first and second members of McArthur et al by connecting them to facilitate proper alignment and orientation of the joint to restore kinematics.

It is noted that MacArthur did not teach of a first articulating surface operative as a weight bearing surface throughout the normal range of motion of the joint for the only one condyle, as claimed by applicant. However, in similar art, Coates et al (FIG.6) evidence the use of a prosthetic implant wherein the first articulating surface operative as a weight bearing surface throughout the normal range of motion of the joint to provide an implant system that restores individual patient joint kinematics.

Therefore, given the teaching of Coates et al, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of MacArthur, as taught by Engh et al to provide an implant system that restores individual patient joint kinematics.

***Allowable Subject Matter***

Claims 8, 9, 10, 14, 29 are allowed.

***Response to Amendment***

Applicant's arguments, see Remarks, filed 5/6/08, with respect to the rejection(s) of claim(s) 1-41 under 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Coates et al. Coates et al discloses an implant having a first member including a first elongate articulating surface, the first articulating

surface operative as a weight bearing surface throughout the normal Range of motion of the joint; as best seen in FIGS.1-6; Wherein any of the first, second, and third members may be implanted irrespective of the implantation of any other of the first, second, and third members.

***Conclusion***

A shortened statutory period for reply to this action is set to expire THREE MONTHS from the mailing date of this action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3733

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Pedro Philogene/  
Primary Examiner, Art Unit 3733  
May 10, 2008